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10/568,020	05/06/2008	Michael Fath	048155.001US	2394
25461 7590 11/24/2009 SMITH, GAMBRELL & RUSSELL SUITE 3100, PROMENADE II 1230 PEACHTREE STREET, N.E. ATLANTA, GA 30309-3592				
			EXAMINER RAMSEY, JEREMY C	
			ART UNIT	PAPER NUMBER
			3634	
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			11/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,020

Applicant(s)

FATH, MICHAEL

Examiner

JEREMY C. RAMSEY

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

Response to Amendment

The following office action is in response to the amendment filed on 07/10/2009. Claims 1 and 8-11 are pending in the application. Claims 2-7 and 12-16 have been cancelled.

Specification

The amendment filed 7/10/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the negative limitation j) not every one of the closure elements (10) is fastened to one of the running carriages (12).

Does not appear to have support. Examiner sees that applicant has support for 'some of' the closure elements suspended to running cartridges, but suspended is narrower than fastened. If applicant can document support, the new matter objection and rejection will be reviewed and cancelled after this final rejection. Note that a lack of positive recitation is not the basis for a negative limitation.

MPEP 2173.05(i) Negative Limitations

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

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A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. In re Wakefield, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation "incapable of forming a dye with said oxidized developing agent" was definite because the boundaries of the patent protection sought were clear. In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph.

as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The previous rejections under 35 USC 112 have been withdrawn.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and its dependent claims 8-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Per the specification objection above, the negative limitation

j) not every one of the closure elements (10) is fastened to one of the running carriages (12).

Does not appear to have support. Examiner sees that applicant has support for 'some of' the closure elements suspended to running cartridges, but suspended is narrower than fastened. **If applicant can document support, the new matter objection and rejection will be reviewed and cancelled after this final rejection. Note that a lack of positive recitation is not the basis for a negative limitation.**

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foltz 3,708,827 in view of Whitley 6,553,618, Owens 5,499,671 and Robinson et al 5,097,883.

1. In re claim 1 with reference to Figures 1-3, Foltz '827 discloses a device for the closure of opening in structures comprising:

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- Vertical closure elements (18) in strip form connected to one another in a hinge-like manner in such a way that they can be turned about a vertical longitudinal central axis.
- Running carriages (10) made to move on a horizontal rail (23) and from which some of the closure elements (18) are suspended, having a bearing body (12), four running wheels (22) made of plastic mounted on two parallel axes and a sliding bearing (22b) made of plastic. (column 1, lines 62-67 and column 2, lines 1-5)
- Two running wheels (22) on an axis connected by a fixed bolt (20) mounted in the bearing body (12) and two sliding bearings (22b).
- The bearings (22b) are assigned to opposite lateral edge regions of the bearing body (12). (Foltz)
- The underside of the running rail (23) has a continuous longitudinal slot (opening on the bottom), narrow bottom edge strips (26) formed on both sides of the slot, and the bearing body (12) being guided in the slot.
- The roller (32) is mounted in a freely rotatable manner.
- A connecting means (14) vertically directed at a central orientation through the bearing body (12), a closure element (18) to which a running carriage is assigned being fastened by the connecting means. (Foltz)

2. Foltz '827 fails to disclose:

- The running wheel fixed to a rotatable bolt mounted in sliding bearings.
- The bearing body is made of plastic.

- The bearing is formed completely in responding receptacles and is non-rotatable and non-displaceable.
- The outer end face of the bearing forms a stop face for the wheel.
- The lower region of the bearing body extends through the longitudinal slot and is assigned at least one guide roller which can rotate about a vertical axis and can be brought into contact with a guiding surface edge of the running rail.
- The closure elements comprise undersides that are guided by a guiding rail having a U-shaped depression.
- The central axes comprise freely rotatable stop rollers that extend upward beyond an upper end and downward beyond a lower end of the closure elements being supported by upper stop faces and lower guiding faces.
- Not every one of the closure elements is fastened to one of the running carriages.

Whitley '618 discloses:

- The running wheel (32) fixed to a rotatable bolt (52) mounted in a sliding bearing (54).
- The bearing (54) is formed completely in responding receptacles (58a)(59a) and is non-rotatable and non-displaceable.

3. With reference to Figures 1 and 2, Owens '671 discloses:

- The lower region (26) of the bearing body extends through the longitudinal slot (22) and is assigned at least one guide roller (32) which

can rotate about a vertical axis and can be brought into contact with a guiding surface edge of the running rail (20).

4. With reference to Figure 2, Robinson et al '883 disclose:

- The closure elements (26) comprise undersides that are guided by a guiding rail (24) having a U-shaped depression (84).
- The central axes comprise freely rotatable stop rollers (108) that extend upward beyond an upper end and downward beyond a lower end of the closure elements being supported by upper stop faces and lower guiding faces.
- Not every one of the closure elements is fastened to one of the running carriages. (Figures 2 and 3 show that element (74) which is used to attach to the carriage is on every other closure element)

5. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the wheel could be fixed to the bolt and the bolt allowed to rotate in a bearing as taught by Whitley '618 since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. It has been clearly shown that it is old and well known to use bearings to support shafts and wheels, and to rearrange the location of the parts does not constitute an inventive step.

Foltz '827 discloses it is known to make parts out of plastic materials therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the bearing body out of plastic, since

it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Doing so would provide a lightweight, cost effective alternative to heavy metal pieces.

6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the guide roller as taught by Owens '671 in order to provide a low friction contact with the edges of the track. (column 4, lines 55-60)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the guide rail having a U-shaped depression on the underside and the top rollers as taught by Robinson et al '883 in order to provide great strength and wind resistance. (column 6, lines 56-60)

7. In re claims 8-10, Foltz discloses:

- The bottom edge strip (26) of the running rail (23) is provided with at least longitudinal groove for the running wheels (22), the guiding means being formed as a longitudinal groove.
- The running wheels (22) lie as close as possible to each other in such a way that the longitudinal central planes of the wheels (22) lie in a common vertical plane which runs through the longitudinal groove in each surface of the bottom edge strip (26)
- The diameter of the running wheels (22) is slightly smaller than the spacing between the parallel axes of the running wheels.

8. In re claim 11, the closure of Foltz '827 has been discussed above but fails to disclose:

- The diameter of the running wheels or the spacing between the parallel axes on which the running wheels are arranged is smaller than the spacing between the vertical central planes of the wheels on opposite ends of the axis, the axial spacing between the wheels being .7 to .9 times the diameter of the running wheels.

However, it would have been an obvious matter of design choice to make the diameter of the running wheels or spacing between the parallel axes be smaller than the spacing between the vertical planes, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Further, changes in size or shape without special functional significance are not patentable. *Research Corp.v. Nasco Industries, Inc.*, 501 F2d 358; 182 USPQ 449 (CA 7) cert. Denied 184 USPQ 193; 43 USLW 3359 (1974). One having ordinary skill in the art could choose to make the size of the running wheels and the spacing between to fit whatever constraints where needed in order to solve a particular problem such as space constraints or overall cost.

Response to Arguments

9. Applicant's arguments filed 07/10/2009 have been fully considered but they are not persuasive.

In response to applicant's arguments that subject matter of the claims is not

found in the references of record one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant states that the features of claims 2-4 are not found in the combination of Foltz and Owens, and the features of claims 6-7 are not found in the combination of Foltz and Whitely. However, these claims were rejected in view of the combination of Foltz, Whitely and Owens; therefore, to leave out the references which teaches the claimed limitation in the combination is improper.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The new grounds of rejection were the limitation taught by Robinson et al '833

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEREMY C. RAMSEY whose telephone number is (571)270-3133. The examiner can normally be reached on Monday-Friday 6:30 am-4:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on 571-272-7069. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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